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09/739,143	12/18/2000	Koichi Hata	MAT-8070US	9841
7590 12/08/2005			EXAMINER	
Lawrence E. Ashery Ratner & Prestia One Westlakes, Berwyn, Suite 301 P.O. Box 980 Valley Forge, PA 19482-0980			VAUGHN, GREGORY J	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/739,143
Filing Date: December 18, 2000
Appellant(s): HATA ET AL.

Lawrence E. Ashery of Ratner & Prestia
For Appellant

EXAMINER'S ANSWER

This examiner answer is in response to the appeal brief filed 10/3/2005 appealing from the Office action mailed 3/1/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-24 stand rejected as recited in the appeal brief.

The rejection of claim 25, made under 35 USC 112, as not being enabled is withdrawn. However, claim 25 remains rejected under 35 USC 103 as recited in the appeal brief.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 25, made under 35 USC 112, as not being enabled is withdrawn. However, claim 25 remains rejected under 35 USC 103 as recited in the appeal brief.

APPELLANT BRIEF CORRECTION

Section VI of appellant's brief fails to list all of the claims appellant wishes to be considered in the appeal as described in Section VII of the brief. Specifically, appellant has failed to list the rejection of claims 5-8, 13-16 and 21-25, rejected under 35 USC 103(a) as being unpatentable over Li et al., US Patent 6,345,279 in view of Fields et al., US Patent 6,606,120 (see Section VII, page 7, first paragraph of appellant's brief where appellant describes arguments related to this rejection).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

Because the rejection of claim 25 made under 35 USC 112 is withdrawn (as described above), the evidence supplied by appellant to support appellant's arguments regarding this rejection is no longer relevant.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1-25 are rejected under 35 USC 103(a). This rejection is set forth in a prior Office Action, mailed on 3/1/2005

(10) Response to Argument

Regarding appellant's argument that *"the cited reference is not directed to 'document-image data' (Page 4, second to last paragraph of the appeal filed 10/3/2005) and 'Appellants have claimed processing of a document image. This is different than LI which teaches the processing of a multi-media page' (Page 5, fourth paragraph of the appeal filed 10/3/2005). The cited reference is Li et al., US Patent 6,345,279 (hereinafter LI).*

The examiner offers the following additional support for the rejection. Appellant's claim 1 calls for: *"A method of processing data, the data including structured image data including document image data and corresponding positioning data ..."* where appellant defines document image data as *"text data, and data of image such as photograph, illustration, graphics and lines"* (page 1, lines 14-15 of the originally filed specification). Li discloses a multimedia document at reference sign 100 in Figures 1 and 3. Li describes the multimedia document as *"Referring to FIG. 1, an example of a multimedia document is shown. As is well known, a Web user (client) makes a request from his client device for some particular Web document(s) or other multimedia content which may contain video, images, graphics, text, audio"* (column 4, lines 4-8). Appellant's *"document image data"* and Li's *"multimedia document"* are defined using similar terms, and therefore are equivalent.

Regarding appellant's argument that: *"Appellants' claim 1 also recites that processed document-image data is replaced by replacing the document-image data and positioning data. There is no teaching of this feature, however, by simply looking at Li*

(Figure 3)" (Page 5, fifth paragraph of the appeal filed 10/3/2005) and appellant's supporting arguments that "*Section 2125 of the MPEP states that it is not proper to use drawings to make arguments based upon measurements*" (Page 5, sixth paragraph of the appeal filed 10/3/2005) the examiner has not used the drawing measurements as a basis for the rejection. In fact, the drawings do not include measurements.

The full recitation of the claim limitation is "*d) renewing the structured image data by replacing the positioning data and the document image data before the processing with positioning data and document imaging data after the processing*". Figure 3 of Li is used to disclose the renewed structure image data (shown in Figure 3 at reference sign 370 as "*Customized Document*"), after the processing (shown in Figure 3 at reference sign 250 as "*Transcode*") of the original document image data (shown in Figure 3 at reference sign 100 as "*Multimedia Document*"). The limitation calls for the document image data (i.e. "content items") to have a position before and after processing. The figure shows document image data items with a position before processing (reference sign 100 of Figure 3) and document image data items with a position after processing (reference sign 370 of Figure 3). The examiner merely uses the figure to show that the data items have a position, and no argument has been made as to the quantity or quality of the position information.

Regarding applicant's argument that the examiner's motivation to combine Li with Fields et al., US Patent 6,605,120 is improper (Page 7, third paragraph and page 8, fifth paragraph of the appeal filed 10/3/2005), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

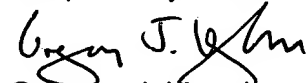
the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Li and fields are analogous art; Li is directed toward "*adapting multimedia content*" and Fields is directed toward "*formatting and reuse of web based content*". Fields teaches the use of multiple inputs (for claim 7) and the use of structure data in the form of a tree (for claim 25). The examiner is motivated to combine Fields with Li because the two references are analogous art, and because an object of Fields' invention is to "*automatically update material*" (Fields, column 2, lines 54-55). Appellant's claimed invention is directed toward updating material (appellant's invention uses the term "*structured image data*" for material, and the terms "*determining, dividing, processing, renewing and outputting*" for update).

Regarding appellant's argument that "*Fields is lacking of appellant's claimed first structured image data and second structured image data*" (Page 7, fourth paragraph of the appeal filed 10/3/2005), because the reference "*only discloses multiple copies of the same image data*" (Page 7, fourth paragraph of the appeal filed 10/3/2005). The examiner contends that there is nothing in appellant's claim 7 that requires the first and second inputs to be different.

Art Unit: 2178

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Gregory J. Vaughn
Patent Examiner
Art Unit 2178
December 5, 2005



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